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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,680	09/30/1999	MASATOSHI NAKANISHI	0234-0372P	5737

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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 02/13/2002

/6

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-18

# Office Action Summary

Appli ation No.

09/409,680

Applicant(s)

NAKANISHI ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-22, 24-29 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 31-35 is/are allowed.
- 6) ☒ Claim(s) 7-13, 17-22 and 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

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### DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-12, 17-21, 24-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Czekai et al ('331).

The '331 patent discloses a submicron particles of material such as pigment useful in paints or a compound useful in imaging element which comprises milling the agent in the presence of milling media having mean particle size of less than about 100 nm (abstract). In column 18 lines 35-45, it is disclosed the preferred range of the dispersed solid particles having particle size of 0.01 to 1  $\mu\text{m}$  and more preferably 0.01 to 0.5  $\mu\text{m}$  and most preferably 0.05 to 0.3  $\mu\text{m}$ . Any suitable compounds useful in the imaging element and the use thereof in the photographic element is described from column 11 to column 35. Czekai may not produce the submicron particles of compound useful in the imaging element having steps presented in the claimed invention. Czeck discloses solid particle having size and composition similar to that of the claimed invention, and

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the size claimed in the present claimed invention is the most preferred. The worker of ordinary skill in the art would have selected the solid particle within the most preferred size taught in the '331 patent because the most critical size found to be most useful. Thus, the claimed invention is either anticipated by or would have been found obvious over Czeck. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process. *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

3. Claims 7-12, 17-21, 24-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Czekai et al ('705).

The '705 patent discloses particle compound useful in imaging elements which are milled using a milling media comprising polymeric resin. The use of polymeric milling media permits the production of particles having an average particle size less than 1 microns (abstract). In column 31, lines 16-23, a solid particle having particle size of 0.1  $\mu\text{m}$ . The compound useful in imaging element in solid particle forms and the use thereof in a photographic material are described in columns 9-31. Czeck discloses solid particle having size and composition similar to that of the claimed invention. Thus, the claimed invention is either anticipated by or would have been found obvious over Czeck. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of

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a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process. *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). "

4. Claims 13-16, 22-23, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '333 patent and '705 patent as applied to claims 7-12, 17-21, 24-28 above, and further in view of Lobo et al (Lobo).

Lobo discloses the use of an ionic polymer within the scope of the claimed invention to create a small particle photographic dispersion of PUMs without increasing the level of surface active material or hydrophilic colloid, without increasing the homogenizing temperature and without the use of auxiliary solvent. Note to the problem to be solved in column 4, lines 10-15, and the polymer in columns 11-12. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the polymer taught in Lobo in the process for preparing a solid fine particle taught in the '333 patent or '05 patent for same reason taught in Lobo, and thereby provide a material as claimed.

5. Claims 12, 21, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '333 patent and '705 patent as applied to claims 7-12, 17-21, 24-18 above, and further in view of Scaringe et al (Scaringe).

The compounds claimed in claim 12, 21, 28 have known as photographic filter dyes and taught in Scaringe in column 7, lines 47-68. It would have obvious to form a solid fine

solid particle of a known photographic useful group including the filter dyes taught in Scaringe, and thereby provide a material as claimed.

6. Claims 1-6 and 31-35 are allowed over the prior art of record.

***Response to Arguments***

Applicant's arguments filed November 13, 2001 have been fully considered but they are not persuasive for same reason set forth in the final rejections dated March 13, 2001. The average grain size of the claimed solid dispersion is within the scope of the average grain size taught in the '331 patent which is less than 100 nm (abstract; column 18, lines 35-45) and within the average grain size exemplified in the '705 patent which is 0.1  $\mu\text{m}$  (column 31, line 18). The Declaration presented in the argument has been considered, but does not overcome the rejection under 35 USC 102(b) set forth above since the process as claimed and the process taught in the '331 and '705 patents produce same product. Moreover, the results shown in the Declaration appears to be contradict with the teach of the prior art. The '331 patent for instance states that its method provides extremely particle, e.g., less than 100 nm, free of unacceptable contamination (abstract). Thus, the Declaration bears a little probative value. Moreover, "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).


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**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tch   
February 11, 2002

  
Thorl Chea  
Primary Examiner  
Art Unit 1752